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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/974,602 | 10/09/2001 | Leslie G. Christie JR. | 10011666-1 | 7054 |

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

NEGRON, DANIEL L

| ART UNIT | PAPER NUMBER |
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2651

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,602

Applicant(s)

CHRISTIE, LESLIE G.

Examiner

Daniell L. Negrón

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-8, 10, 12-16, 19-22, 24-29, 34-37, and 39-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Takayama Japanese Patent Application Publication No. 2000-268443.

Regarding claims 1, 3-8, 10, 12-16, 19-22, 24-29, 34, and 42-50, claims 1, 3-8, 10, 12-16, 19-22, 24-29, 34, and 42-50 are rejected for the same reasons discussed in the prior Office action paper no. 7 mailed on January 2, 2004 (see Response to Arguments).

Regarding claim 35, claim 35 has limitations similar to those treated in the rejection of claim 1, and are met by the references as discussed in the prior Office action (see Response to Arguments).

Regarding claim 36, Takayama discloses a magnetic tape drive comprising means for initiating the drive in a standard read/write mode (paragraphs 6 and 9-11 as discussed in prior Office action).

Regarding claim 37, claim 37 has limitations similar to those treated in the above rejection of claim 28 and are met by the references as discussed above.

Regarding claim 39, claim 39 has limitations similar to those treated in the rejection of claim 3, and are met by the references as discussed in the prior Office action (see Response to Arguments).

Regarding claims 40 and 41, claims 40 and 41 have limitations similar to those treated in the above rejections of claims 39 and 37 respectively and are met by the references as discussed in the prior Office action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 11, 23, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama Japanese Patent Application Publication No. 2000-268443 in view of Morita U.S. Patent No. 5,612,827.

Regarding claims 2, 11, and 23, claims 2, 11, and 23 are rejected for the same reasons discussed in the prior Office action paper no. 7 mailed on January 2, 2004 (see Response to Arguments).

Regarding claim 38, claim 38 has limitations similar to those treated in the rejection of claim 2, and are met by the references as discussed in the prior Office action (see Response to Arguments).

5. Claims 9, 17, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama Japanese Patent Application Publication No. 2000-268443 in view of Amamiya Japanese Patent Application Publication No. 2000-295507.

Regarding claims 9, 17, 32, and 33, claims 9, 17, 32, and 33 are rejected for the same reasons discussed in the prior Office action paper no. 7 mailed on January 2, 2004 (see Response to Arguments).

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama Japanese Patent Application Publication No. 2000-268443 in view of Amamiya Japanese Patent Application Publication No. 2000-295507 as applied to claim 17 above, and further in view of Kita U.S. Patent No. 5,199,593.

Regarding claim 30, claim 30 is rejected for the same reasons discussed in the prior Office action paper no. 7 mailed on January 2, 2004 (see Response to Arguments).

7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama Japanese Patent Application Publication No. 2000-268443 in view of Amamiya Japanese Patent Application Publication No. 2000-295507 as applied to claim 17 above, and further in view of Heigl U.S. Patent No. 4,746,796.

Regarding claim 31, claim 31 is rejected for the same reasons discussed in the prior Office action paper no. 7 mailed on January 2, 2004 (see Response to Arguments).

Response to Arguments

8. Applicant's arguments filed March 25, 2004 (paper no. 8) of the objection to the drawings have been fully considered and are persuasive, therefore objection made to drawings has been withdrawn by the Examiner.

9. Applicant's arguments filed March 25, 2004 (paper no. 8) of the rejection of claims 1, 3-8, 10, 12-16, 19-22, 24-29, 34, 35, 39, and 42-50 under 35 U.S.C. § 102(b) have been fully considered but they are not persuasive.

Regarding claims 1, 10, 19, and 42, Applicant on pages 9 and 10 of the response filed on January 7, 2004 argues that Takayama Japanese Patent Application Publication No. 2000-268443 (hereinafter Takayama) fails to show a tape characteristic differing from standard type tapes, however the Examiner respectfully disagrees. Takayama discloses a magnetic tape comprising characteristics (e.g., tape length, memory chip data structure), which differ the tape from "standard" type tapes. Takayama further discloses the memory chip comprising information, which identifies the tape type and contains information on how the drive is to read/write to/from the magnetic tape (paragraph 10). Examiner considers the tape disclosed by Takayama as consistent with the "tape type" as claimed by Applicant. Examiner further considers the recitation "characteristic" as being merely a feature or trait of the magnetic tape and therefore it is considered that Takayama meets the limitations of independent claims 1, 10, and 19. Furthermore, it is noted that the features upon which Applicant relies (i.e., basis for limitation on line 1 of page 8 of the specification) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claim 48, Applicant on pages 12 and 13 of the response argues that Takayama fails to show a tape drive determining, based on the cartridge type information, whether the tape cartridge is one of a read/write cartridge and a write-once-read-many cartridge and in response to

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a determination that the tape cartridge is a read/write cartridge, enabling the tape drive to perform overwriting and erasing of data on the read/write cartridge, however the Examiner respectfully disagrees. Takayama in paragraph 9 discloses to disable erasing, overwriting, or changing data based on type information (i.e. application identification information), otherwise, erasing, overwriting or changing information is enabled. Takayama discusses this feature more in detail in paragraph 72 in describing the "worm flag". The "worm flag" is considered as an indicator, which the drive utilizes to determine whether the tape is in "normal" or "worm" (write-once-read-many) mode. Therefore it is considered that the disclosure of Takayama is consistent with a cartridge type determination and further consistent with an enabling of overwriting and erasing of data and therefore is considered to meet the limitations as claimed by Applicant.

Regarding claims 35 and 39, in the previous Office action, Examiner explains that the limitations of claims 35, 38, and 39 are similar to those claimed in claims 1, 2, and 3, therefore claims 35, 38, and 39 were rejected for the same reasons explained in the rejections of claims 1, 2, and 3. For clarification purposes, Examiner above explains that the limitations of claim 35 correspond to the limitations of claim 1 and therefore rejected under 35 U.S.C. § 102 over Takayama. Examiner further explains that the limitations of claim 39 correspond to the limitations of claim 3 and therefore rejected under 35 U.S.C. § 102 over Takayama. Finally, Examiner above explains that the limitations of claim 38 correspond to the limitations of claim 2 and therefore rejected under 35 U.S.C. § 103 over Takayama in view of Morita.

10. Applicant's arguments filed March 25, 2004 (paper no. 8) of the rejection of claims 2, 11, 9, 17, 23, 30-33, and 38 under 35 U.S.C. § 103(a) have been fully considered but they are not persuasive.

Regarding claims 2, 11, 9, 17, 23, and 30-33, Applicant's argument that Takayama, Amamiya, Kita, Morita, and/or Heigl either alone or in combination fail to teach or suggest all the limitations of the claimed invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Regarding claim 38, as explained above for clarification purposes, the limitations of claim 38 correspond to the limitations of claim 2 and therefore rejected under 35 U.S.C. § 103 over Takayama in view of Morita.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniell L. Negrón whose telephone number is 703-305-6985.

The examiner can normally be reached on Monday-Friday (8:30-6:00) Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Hudspeth can be reached on 703-308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DLN:
June 9, 2004


DAVID HUDSPETH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600